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NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER DISTEFANO, GREGORY A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/701,180

**Applicant(s)**

RALEY ET AL.

**Examiner**

GREGORY A. DISTEFANO

**Art Unit**

2175

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 10-12, 14-16, 20, 21, 24, 25, 79, 81-91 and 93-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 10-12, 14-16, 20, 21, 24, 25, 79, 81-91 and 93-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-944)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to the amendment filed on 8/13/2009.
2. Claims 1, 3, 10-12, 14-16, 20, 21, 24, 25, and 79, 81-91, and 93-101 are currently pending.

***Specification***

3. The previous objections to the specification are hereby withdrawn due to applicant's arguments filed 8/13/2009

***Claim Objections***

4. The previous objections to claims 25 and 90 are hereby withdrawn due to applicant's arguments filed 8/13/2009.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The previous rejections of claims 25 and 90 under 35 U.S.C. 112, second paragraph, are hereby withdrawn due to applicant's arguments filed 8/13/2009.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 14-16, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Hord et al. (US 2004/0034874), hereinafter Hord.

9. As per claim 1, Hord teaches the following:

*detecting a fast forward action performed by the content consumption device during rendering of the preferred content that makes available the audio output channel of the content consumption device by the performing of the fast forward action, (pg. 8, paragraph [0067]), i.e. Fig. 5C is a screen diagram of an example rewind display screen 580 that is similarly structured to the fast forward display screen 540;*

*selecting audio content to be played on the content consumption device on the available audio output channel based on an automated algorithm that selects audio content to be played from a repository of targeted audio content, (pg. 11, paragraph [0088]), i.e. step 840 includes the step of evaluating decision data to determine the advertisement to use and how to present the advertisement;*

*playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the fast forward action, (pg. 8, paragraph [0067]), i.e. as shown, the rewind display screen 580 includes an audio advertisement presented during the rewinding through a presentation of camping hotspots.*

10. Regarding claim 14, Hord Thomas teaches the method of claim 1 as described above. Hord further teaches the following:

*providing software code in the content consumption device for causing the playing of the selected audio content, (pg. 4, paragraph [0035]), i.e. under control of software applications executing from system memory 349, the processor 344 generates graphical and textual data and stores them in system memory 349. The textual and graphical data may, for example, be generated for the purposes of presenting advertisements in a trick mode display.*

11. Regarding claim 15, modified Hord teaches the method of claim 1 as described above. Hord further teaches the following:

*providing software code in a medium used by the content consumption device for causing the playing of the selected audio content, (pg. 4, paragraph [0035]), i.e. under control of software applications executing from system memory 349, the processor 344 generates graphical and textual data and stores them in system memory 349. The textual and graphical data may, for example, be generated for the purposes of*

presenting advertisements in a trick mode display.

12. Regarding claim 16, modified Hord teaches the method of claim 1 as described above. Hord further teaches the following:

*transmitting a signal to the content consumption device for causing the playing of the selected audio content*, (pg. 4, paragraph [0035]), i.e. the advertisements can be carried as one or more MPEG frames and processed like any other video signal at the DHCT 16.

13. Regarding claim 24, modified Hord teaches the method of claim 1 as described above. Hord further teaches the following:

*the selected audio content is labeled as at least one of audio content, personalized advertisement audio content, and regional advertisement audio content.* Hord teaches in page 10, paragraph [0078] that the advertising content may be audio content and personalized to the user.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hord as applied to claim 1 above, in view of Joao (US 2001/0056374).

16. Regarding claim 3, modified Hord teaches the method of claim 1 as described above. However, Hord does not explicitly teach a method of providing a benefit to a user that plays the advertising content. Joao teaches the following:

*providing a benefit to a user of the content consumption device in exchange for playing the selected audio content, (abstract), i.e. an apparatus for providing compensation for viewing and/or for participating in an advertisement, a survey, a poll, or a questionnaire, including a receiver for receiving a request to obtain information regarding at least one of a good, a product, and a service.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the advertisement method of Hord with the compensation method of Joao. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Joao are analogous

art in the field of providing advertisements to users. Furthermore, as Joao teaches in page 1, paragraph [0006], "while the basic notion of compensating individuals for viewing advertisements has been introduced, current practices fall far too short of realizing the true potential of utilizing the Internet, the World Wide Web, and/or any other communication network, in providing compensation, rewards, rebates, and/or incentives, to individuals or entities for viewing, participating in, and/or interacting with, advertisements, surveys, polls, and/or questionnaires".

17. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hord as applied to claim 1 above, in view of Thomas et al. (US 2003/0037068), hereinafter Thomas.

18. Regarding claim 10, Hord teaches the method of claim 1 as described above. Thomas further teaches the following:

*the selected audio content is a personal message, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content. The interactive media application may provide customized pause-time content specific to the user or specific to the media paused by using media data associated with the media.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the audio content of Hord with the personal Message of Thomas. One of ordinary skill in the art would have been motivated to have



made such modifications because both Hord and Thomas are analogous art in the field of presenting alternative content during playing of video content in a mode other than basic playing of the video. Furthermore, Hord teaches in page 10, paragraph [0078], of a desire to personalize the advertisements they display, thus showing a desire to provide content customized for a particular user.

19. Regarding claim 11, modified Hord teaches the method of claim 1 as described above. Hord further teaches the following:

*determining a preference of a user of the content consumption device, wherein the determined user preference includes at least one of a shopping preference, a show preference, a purchase history, a music preference, and a video preference, (pg. 10, paragraph [0078]), i.e. the decision data can be input into the look up table structure of the decision module, which, under processor and application control, matches the decision data with a set of rules for presenting an appropriate advertisement during the trick mode display. The rules can be based in part on the user behavior and viewing habits;*

However, Hord does not explicitly teach a method of populating the repository with content based on the user preferences. Thomas teaches the following:

*populating the repository of audio content based upon the determined user preference, (pg. 4, paragraph [0043]), i.e. the interactive media application may store some or all of the pause-time content on user equipment 40. The interactive media application may update the stored pause-time content periodically, on-demand, via*

polling, or by any other suitable approach. Specific pause-time content may be stored and updated according to the media data.

It would have been obvious to one of ordinary skill in the art to have modified the content of Hord with the content repository of Thomas. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Thomas are analogous art in the field of presenting alternative content during playing of video content in a mode other than basic playing of the video. Furthermore, Hord teaches in page 10, paragraph [0078], of customizing the list of advertisements they present using a look up table structure in the decision module, thus showing a desire to construct custom made lists (repository) of advertisements to utilize.

20. Regarding claim 12, modified Hord teaches the method of claim 11 as described above. Hord further teaches the following:

*playing the selected audio content based on the determined user preference,* (pg. 2, paragraph [0041]), i.e. presentation methods in the receiver display the content based on protocol, format and opportunities created by function invocation by the user, physical and temporal content availability, and processes for matching the content to the opportunities.

21. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hord as applied to claim 1 above, in view of Bacso et al. (US 2002/0124182), hereinafter Bacso

22. Regarding claim 20, Hord teaches the method of claim 1 as described above. However, Hord does not explicitly teach a method of documenting user actions. Bacso teaches the following:

*message documenting the detected fast forward action*, (pg. 8, paragraph [0191]), i.e. the presentation method can also handle and manage user input to control the triggering of functional opportunities. The logging of results can include all inputs from the user.

It would have been obvious to one of ordinary skill in the art to have modified the user inputs of Hord with the input logging of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, Hord anticipates the desire to track user behavior as may be seen in their teaching in page 10, paragraph [0078], where they discuss deciding on a particular advertisement based upon past user behavior information.

23. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hord in view of Bacso as applied to claim 20 above, and further in view of Nishio (GB 2,302,635 A).

24. Regarding claim 21, modified Hord teaches the method of claim 20 as described above. However, Hord does not explicitly teach of fast forwarding to skip a commercial being played. Nishio further teaches the following:

*the detected fast forward action includes skipping of a commercial being played on the content consumption device, (pg. 4, 2<sup>nd</sup> paragraph), i.e. it is possible for each subscriber to skip or neglect such an advertisement or commercial video program by the use of such a reproduction control command.*

It would have been obvious to one of ordinary skill in the art to have modified the fast forwarding content of Hord with the skipped commercials of Nishio. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Nishio are analogous art in the field of presenting advertisements to television users. Furthermore, Hord never limits themselves to the type of content which may be presented when a fast forwarding action is performed.

25. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hord as applied to claim 1 above, in view of Frerichs et al. (US 6,684,249), hereinafter Frerichs.

26. Regarding claim 25, Hord teaches the method of claim 1 as described above. However, Hord does not explicitly teach a method where the selected and preferred content are played on a single audio channel. Frerichs teaches the following:

*the audio output channel is not free, and further comprising:*  
*playing the selected audio content on the content consumption device on a portion of the available audio output channel, (column 2, lines 25-30), i.e. the method also includes inserting an advertisement into the audio data; and*

*playing preferred content on the content consumption device on a remaining portion of the available audio output channel, (column 2, lines 25-30), i.e. the method also includes inserting an advertisement into the audio data while simultaneously reducing an audio volume level of the audio data and simultaneously outputting the audio data and the advertisement where an advertisement volume level is selected for a user to hear the advertisement while playing the audio data in a song format as background noise.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the audio advertising method of Hord with the audio overlay method of Ferichs. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Ferichs are analogous art in the field of providing audio advertisements while a user views a video. Furthermore, Hord discusses embedding the advertisement information into the video signal in page 4, paragraph [0035], thus showing the capability to send multiple signals.

27. Claims 79, 81, and 84-86 are rejected under 35 U.S.C. 102(e) as being unpatentable over Thomas in view of Joao.

28. As per claim 79, Thomas teaches the following:

*detecting a pause action performed by the content consumption device during rendering of preferred content that makes available the audio output channel of the content consumption device by the performing of the pause action, (abstract), i.e. if the user **pauses** real-time media or near video-on-demand media, the interactive media*

application may store the media. The interactive media application may also provide the user with the ability to rewind, resume play of, and fast-forward the media;

*selecting audio content to be played on the content consumption device on the available audio output channel based on an automated algorithm that selects audio content to be played from a repository of audio content, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content. The interactive media application may provide customized pause-time content specific to the user or specific to the media paused by using media data associated with the media, (pg. 2, paragraph [0023]), i.e. main facility 34 may also store and distribute pause-time content, which may be media, media data, or both;*

The examiner interprets Thomas's method of customizing content using specific variables to encompass applicant's "automated algorithm"; and

*playing the selected audio content on the content consumption device on the available audio output channel simultaneously with the preferred content during the performing of the pause action, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content.*

The examiner would like to note that as the advertisement of Thomas may be purely audio, it would have been clear to one of ordinary skill in the art that the paused content may still be displayed as the advertisement is only utilizing the audio channel.

However, Thomas does not explicitly teach a method of providing a benefit to a user that plays the advertising content. Joao teaches the following:

*providing a benefit to a user of the content consumption device in exchange for playing the selected audio content, (abstract), i.e. an apparatus for providing compensation for viewing and/or for participating in an advertisement, a survey, a poll, or a questionnaire, including a receiver for receiving a request to obtain information regarding at least one of a good, a product, and a service.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the advertisement method of Hord with the compensation method of Joao. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Joao are analogous art in the field of providing advertisements to users. Furthermore, as Joao teaches in page 1, paragraph [0006], "while the basic notion of compensating individuals for viewing advertisements has been introduced, current practices fall far too short of realizing the true potential of utilizing the Internet, the World Wide Web, and/or any other communication network, in providing compensation, rewards, rebates, and/or incentives, to individuals or entities for viewing, participating in, and/or interacting with, advertisements, surveys, polls, and/or questionnaires".

29. Regarding claim 81, modified Thomas teaches the method of claim 79 as described above. Thomas further teaches the following:

*the selected audio content is a personal message*, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content. The interactive media application may provide customized pause-time content specific to the user or specific to the media paused by using media data associated with the media.

The examiner would like to further note that applicant's "personalized message" clearly fails under Thomas's description of "suitable pause-time content" and "customized content specific to the user".

30. Regarding claim 84, modified Thomas teaches the method of claim 79 as described above. Thomas further teaches the following:

*providing software code in the content consumption device for causing the playing of the selected audio content*, (see pg. 2, paragraph [0029]).

31. Regarding claim 85, modified Thomas teaches the method of claim 79 as described above. Thomas further teaches the following:

*providing software code in a medium used by the content consumption device for causing the playing of the selected audio content*, (see pg. 2, paragraph [0029]).

32. Regarding claim 86, modified Thomas teaches the method of claim 79 as described above. Thomas further teaches the following:



*transmitting a signal to the content consumption\_device for causing the playing of the selected audio content*, (pg. 7, paragraph [0068]), i.e. at step 620, the interactive media application may substitute pause-time content in place of the paused VOD or recorded media that is currently playing.

The examiner would like to further note that in order for Thomas's device to play pause-time content, it would first have to receive a signal to do so, such as receiving the pause command from the user.

33. Claims 82, 83, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Joao as applied to claim 79 above, and further in view of Bacso.

34. Regarding claim 82, modified Thomas teaches the method of claim 79 as described above. However, Thomas does not explicitly teach a method of determining user preferences and populating the repository with content based on the user preferences. Bacso teaches the following:

*determining a preference of a user of the content consumption device, wherein the determined user preference includes at least one of a shopping preference, a show preference, a purchase history, a music preference, and a video preference*, (pg. 2, paragraph [0041]), i.e. the matching process may have complex requirements including multi-service broadcaster requirements, multi-message content sequencing, and user preferences including ratings and permissions; and

*populating the repository of audio content based upon the determined user preference*, (pg. 5, paragraph [0084]), i.e. Fig. A4 shows a list of content and related characteristics. The content type 81 allows the receiver to determine if it is capable of showing the content. The examiner interprets a list of content which may be displayed under Bacso to encompass applicant's limitation.

It would have been obvious to one of ordinary skill in the art to have modified the content of Thomas with the user preference based content of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, as Bacso teaches in pg.1, paragraphs [0008] – [0022], targeting advertising was already well known in the art. Still further, Thomas discusses user preferences in page 5, paragraph [0050] and building a customized repository in page 4, paragraph [0043].

35. Regarding claim 83, modified Thomas teaches the method of claim 82 as described above. Bacso further teaches the following:

*playing the selected audio content based on the determined user preference*, (pg. 2, paragraph [0041]), i.e. presentation methods in the receiver display the content based on protocol, format and opportunities created by function invocation by the user, physical and temporal content availability, and processes for matching the content to the opportunities.

36. Regarding claim 87, modified Thomas teaches the method of claim 79 as described above. However, Thomas does not explicitly teach a method of documenting user actions. Bacso teaches the following:

*message documenting the detected pause action*, (pg. 8, paragraph [0191]), i.e. the presentation method can also handle and manage user input to control the triggering of functional opportunities. The logging of results can include all inputs from the user.

It would have been obvious to one of ordinary skill in the art to have modified the user inputs of Thomas with the input logging of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, such input logging would allow (Bacso, pg. 8, paragraph [0191]), “these inputs can be processed within the receiver or at a network site to as part of the analysis of viewing habits”.

37. Regarding claim 88, modified Thomas teaches the method of claim 87 as described above. Thomas further teaches the following:

*the detected pause action includes pausing of a commercial being played on the content consumption device*, (abstract), i.e. the user may pause media such as real-time media, video-on-demand, or recorded media.

As was well known at the time, all three of Thomas's example media (real-time, video-on-demand, or recorded) could have included commercials and therefore the commercials could have been paused while being played using Thomas's method.

38. Regarding claim 89, modified Thomas teaches the method of claim 79 as described above. However, Thomas does not explicitly teach a method of where the content is labeled. Bacso teaches the following:

*distributing content to the content consumption device, including content that is at least one of labeled as preferred audio content, labeled as personalized advertisement audio content, and labeled as regional advertisement audio content, (pg. 5, paragraph [0085]), i.e. the content characteristics 83 describe the contents targeting attributes. The number and types of characteristics are dynamic, and can grow or change over time.*

As may be seen in Bacso's showing of Fig. A4, one of the "content characteristics" listed is "Area" which specifies the geographic region in which the ad is to be displayed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the pause-time content of Thomas with the content labeling of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Bacso are analogous art in the field of presenting advertisements to television users. Furthermore, Thomas teaches in page 4, paragraph [0042], that the pause-time content may be customized

for certain aspects. One of ordinary skill in the art would have seen the benefit of labeling the substitute content to aid in customizing the substitute content to be displayed.

39. Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Joao as applied to claim 79 above, and further in view of Frerichs.

40. Regarding claim 90, modified Thomas teaches the method of claim 79 as described above. However, Thomas does not explicitly teach a method where the selected and preferred content are played on a single audio channel. Frerichs teaches the following:

*the audio output channel is not free, and further comprising:*

*playing the selected audio content on the content consumption device on a portion of the available audio output channel, (column 2, lines 25-30), i.e. the method also includes inserting an advertisement into the audio data; and*

*playing preferred content on the content consumption device on a remaining portion of the available audio output channel, (column 2, lines 25-30), i.e. the method also includes inserting an advertisement into the audio data while simultaneously reducing an audio volume level of the audio data and simultaneously outputting the audio data and the advertisement where an advertisement volume level is selected for a user to hear the advertisement while playing the audio data in a song format as background noise.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the audio advertising method of Thomas with the audio overlay method of Ferichs. One of ordinary skill in the art would have been motivated to have made such modifications because both Thomas and Ferichs are analogous art in the field of providing audio advertisements during an on-demand type service.

41. Claims 91, 97 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg et al. (US 6,351,736), hereinafter Weisberg, in view of Joao.

42. As per claim 91, Weisberg teaches the following:

*detecting a radio mode action performed by the content consumption device during rendering of preferred content that makes available the video output channel of the content consumption device by the performing of the radio mode action, (abstract), i.e. a method and system for playing a first type of data, such as audio stream data, for the user;*

*selecting video content to be played on the content consumption device on the available video output channel based on an automated algorithm that selects video content to be played from a repository of video content, (abstract), i.e. a method and system for playing a first type of data, such as audio stream data, for the user while simultaneously displaying an advertisement in the form of a second type of data, such as video data, (column 6, lines 3-5), i.e. advertisement management module first selects*

the advertisement, for example according to the content of the audio data, (column 6, lines 20-22), i.e. the audio files and the advertisements may be retrieved from different server computers; and

*playing the selected video content on the content consumption device on the available video output channel simultaneously with the preferred content during the performing of the radio mode action*, (abstract), i.e. a method and system for playing a first type of data, such as audio stream data, for the user while simultaneously displaying an advertisement in the form of a second type of data, such as video data.

However, Weisberg does not explicitly teach a method of providing a benefit to a user that plays the advertising content. Joao teaches the following:

*providing a benefit to a user of the content consumption device in exchange for playing the selected audio content*, (abstract), i.e. an apparatus for providing compensation for viewing and/or for participating in an advertisement, a survey, a poll, or a questionnaire, including a receiver for receiving a request to obtain information regarding at least one of a good, a product, and a service.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the advertisement method of Hord with the compensation method of Joao. One of ordinary skill in the art would have been motivated to have made such modifications because both Hord and Joao are analogous art in the field of providing advertisements to users. Furthermore, as Joao teaches in page 1, paragraph [0006], "while the basic notion of compensating individuals for viewing advertisements has been introduced, current practices fall far too short of

realizing the true potential of utilizing the Internet, the World Wide Web, and/or any other communication network, in providing compensation, rewards, rebates, and/or incentives, to individuals or entities for viewing, participating in, and/or interacting with, advertisements, surveys, polls, and/or questionnaires".

43. Regarding claim 97, modified Weisberg teaches the method of claim 91 as described above. Weisberg further teaches the following:

*providing software code in a medium used by the content consumption device for causing the playing of the selected video content*, (column 5, lines 56-58), i.e.

advertisement module 20 features a video display module 26 which drives the display of the video data on display screen 22 by communicating with video card 24. Video display module 26 is preferably implemented as a video codec software program.

44. Regarding claim 98, modified Weisberg teaches the method of claim 91 as described above. Weisberg further teaches the following:

*transmitting a signal to the content consumption device for causing the playing of the selected video content*, (column 5, lines 56-58), i.e. advertisement module 20 features a video display module 26 which drives the display of the video data on display screen 22 by communicating with video card 24. Video display module 26 is preferably implemented as a video codec software program.



45. Claims 94, 95, 96, 99, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of Joao as applied to claim 91 above, and further in view of Bacso.

46. Regarding claim 94, modified Weisberg teaches the method of claim 91 as described above. However, Weisberg does not explicitly teach a method of determining user preferences and populating the repository with content based on the user preferences. Bacso teaches the following:

*determining a preference of a user of the content consumption device, wherein the determined user preference includes at least one of a shopping preference, a show preference, a purchase history, a music preference, and a video preference, (pg. 2, paragraph [0041]), i.e. the matching process may have complex requirements including multi-service broadcaster requirements, multi-message content sequencing, and user preferences including ratings and permissions; and*

*populating the repository of video content based upon the determined user preference, (pg. 5, paragraph [0084]), i.e. Fig. A4 shows a list of content and related characteristics. The content type 81 allows the receiver to determine if it is capable of showing the content. The examiner interprets a list of content which may be displayed under Bacso to encompass applicant's limitation.*

It would have been obvious to one of ordinary skill in the art to have modified the content of Weisberg with the user preference based content of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because

both Weisberg and Bacso are analogous art in the field of presenting advertisements to users. Furthermore, as Bacso teaches in pg.1, paragraphs [0008] – [0022], targeting advertising was already well known in the art.

47. Regarding claim 95, modified Weisberg teaches the method of claim 94 as described above. Bacso further teaches the following:

*playing the selected video content based on the determined user preference*, (pg. 2, paragraph [0041]), i.e. presentation methods in the receiver display the content based on protocol, format and opportunities created by function invocation by the user, physical and temporal content availability, and processes for matching the content to the opportunities.

48. Regarding claim 96, modified Weisberg teaches the method of claim 94 as described above. Weisberg further teaches the following:

*providing software code in the content consumption device for causing the playing of the selected video content*, (column 2, lines 17-19), i.e. by "playing", it is meant that the content of the data is presented to the user by a hardware device, optionally in combination with software.

49. Regarding claim 99, modified Weisberg teaches the method of claim 91 as described above. However, Weisberg does not explicitly teach a method of documenting user actions. Bacso teaches the following:

*message documenting the detected radio mode action*, (pg. 8, paragraph [0191]), i.e. the presentation method can also handle and manage user input to control the triggering of functional opportunities. The logging of results can include all inputs from the user.

It would have been obvious to one of ordinary skill in the art to have modified the user inputs of Weisberg with the input logging of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Weisberg and Bacso are analogous art in the field of presenting advertisements to users. Furthermore, such input logging would allow (Bacso, pg. 8, paragraph [0191]), "these inputs can be processed within the receiver or at a network site to as part of the analysis of viewing habits".

50. Regarding claim 100, modified Weisberg teaches the method of claim 91 as described above. However, Weisberg does not explicitly teach a method of where the content is labeled. Bacso teaches the following:

*distributing content to the content consumption device, including content that is at least one of labeled as preferred video content, labeled as personalized advertisement video content, and labeled as regional advertisement video content*, (pg. 5, paragraph [0085]), i.e. the content characteristics 83 describe the contents targeting attributes. The number and types of characteristics are dynamic, and can grow or change over time.

As may be seen in Bacso's showing of Fig. A4, one of the "content characteristics" listed is "Area" which specifies the geographic region in which the ad is to be displayed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the ad content of Weisberg with the content labeling of Bacso. One of ordinary skill in the art would have been motivated to have made such modifications because both Weisberg and Bacso are analogous art in the field of presenting advertisements to users.

51. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of Joao as applied to claim 91 as described above, and further in view of Thomas.

52. Regarding claim 93, modified Weisberg teaches the method of claim 91 as described above. However Weisberg does not explicitly teach that the selected content is a personal message. Thomas further teaches the following:

*the selected audio content is a personal message, (abstract), i.e. the pause-time content may be audio or video media and may be an advertisement, trivia, program summaries or any other suitable pause-time content. The interactive media application may provide customized pause-time content specific to the user or specific to the media paused by using media data associated with the media.*

It would have been obvious to one of ordinary skill in the art to have modified the video advertisements of Weisberg with the personal messages of Thomas. One of ordinary skill in the art would have been motivated to have made such modifications because both Weisberg and Thomas are analogous art in the field of presenting advertisements to users.

53. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisberg in view of Joao as applied to claim 91 as described above, and further in view of Tsuchida et al. (US 2002/0194592), hereinafter Tsuchida.

54. Regarding claim 101, modified Weisberg teaches the method of claim 91 as described above. However, Weisberg doesn't explicitly teach a method where the preferred content is displayed with the selected content. Tsuchida teaches the following:

*the video output channel is not free, and further comprising:*

*playing the selected video content on the content consumption device on a portion of the available video output channel, (pg. 2, paragraph [0031]), i.e. the substitute content may be displayed as the main screen view, while the live or other programming content is displayed as a picture-in-picture on the television screen; and*

*playing preferred content on the content consumption device on a remaining portion of the available video output channel, (pg. 2, paragraph [0031]), i.e. the substitute content may be displayed as the main screen view, while the live or other*

programming content is displayed as a picture-in-picture on the television screen.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the substitute content display of Weisburg with the picture-in-picture method of Tsuchida. One of ordinary skill in the art would have been motivated to have made such modifications because both Weisburg and Tsuchida are analogous art in the field of displaying substitute content to the user.

### ***Response to Arguments***

55. Applicant's arguments with respect to claims 1, 25, 79, 90, and 91 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY A. DISTEFANO whose telephone number is (571)270-1644. The examiner can normally be reached on Monday through Friday, 9 a.m. - 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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